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PATENT
P55971

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Official

In re Application of:

KI-SEON KIM et al.

FAX RECEIVED

Serial No. : 09/503,240

Examiner: FISHER, MICHAEL APR 26 2002

Filed : 14 February 2000

Art Unit: 3636

GROUP 3600

For : MONITOR CASE COMPRISING FACILE DETACH STRUCTURE

REQUEST FOR CLARIFICATION AND
PETITION UNDER 37 C. F.R. §1.181**VIA FACSIMILE**Assistant Commissioner for Patents
Washington, D.C. 20231

Facsimile No.: (703) 305-7687

Sir:

Applicant respectfully requests clarification of the final rejection set forth on Paper No.8 in light of the Examiner's assertion in Paper No.10, that Applicant's "arguments are not persuasive", and respectfully requests the Commissioner to direct the Examiner to withdraw the finality of the rejection set forth on Paper No.8 under 37 C.F.R. §1.104(b) and (c), and these reasons therefore states that:

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P55971**STATEMENT OF FACTS**

1. In Paper No.8 dated 15 January 2002, the Examiner issued the rejection of Applicant's apparatus claims 1, 13 and 16 and Applicant's method claims 21-25, under the doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026 by Ki-Seon Kim, assigned to the same assignee as the above-captioned U.S. patent application.

2. In Applicant's Response timely filed on the 10th of April 2002, Applicant traversed this rejection and explained the absence of one-way obviousness, and noted that the failure of the Examiner to either provide the completeness required under 37 C.F.R. §1.103(b) and (c) in formulating the rejection as well as the failure of the Examiner to comply with the requirements for making an obviousness-type double patenting rejection.

3. Subsequently, in the Advisory Action dated 22 April 2002 (Paper No. 10), the Examiner neglected to address any of the issues raised in the Applicant's Response of 10 April 2002, and instead simply asserted that Applicants "arguments are not persuasive."

4. Both the rejection set forth in Paper No.8 and the Examiner's explanation of that rejection, is singularly devoid of the requirements mandated for a imposition of obviousness-type double patenting rejection, namely:

(A) A determination of the scope and content of the patent claim(s) of Kim '026 relative to each of the claims rejected in this application;

(B) A determination of the differences between the scope and content of the applied patent

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claim(s) of Kim '026 and the prior art as determined in (A) and the claim rejected in the above-captioned application;

(C) A determination of the level of the ordinary skill in prior art; and

(D) An evaluation of any objective indicia of non-obviousness.

5. The non-obviousness type double patenting rejection set forth in Paper No.8 and the Examiner's explanation of that rejection is also completely devoid of any statement by the Examiner as suggested by §804 of the *Manual*, such as:

(A) The differences between the inventions defined by their conflicting claims, namely a comparison of the applied claims of the Kim '026 patent and each of the rejected claims in the above-captioned application; and

(B) The reasons why person of ordinary skill in art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in the claim of the patent.

6. Instead, the Examiner has relied upon this disclosure, and specifically, the drawings, as prior art, despite the express provision against this set forth in the *Manual of Patent Examining Procedure* (eighth edition), §804.

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P55971REMARKS

The *Manual of Patent Examining Procedure* (eighth edition), §804 expressly explains the four factual inquiries to be undertaken by the Examiner, as listed above as paragraphs (A) through (D). None of these factual inquiries has either been made or explained in Paper No.10. Moreover, Paper No.10 is devoid of any clear explanation of either the differences between the inventions defined by the conflicting claims or any explanation of the reasons why person of ordinary skill of art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent. In short, the Examiner has not only failed and refused to comply with the requirement for completeness set forth in 37 C.F.R. §1.104(b), as completeness in the imposition of the obviousness-type double patenting rejection is outlined by §804 of the *Manual*, but has failed to identify the particular parts of each claim applied from Kim '026 and comparable limitations of the Applicant's rejected claims.

In short, the Examiner's style is not helpful and is contrary to both the requirement for completeness and the procedures outlined by the manual. By way example, it is extremely difficult to understand how Applicant's process claims 21-25 might be properly rejected by the apparatus claims of Kim '026; these claims are statutorily different in class and in subject matter. The Examiner has neglected to explain either the application of Kim '026 or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claims 21-25. Also, no comparison has been made to support rejection of Applicant's claims 1, 13 and 16.

Deviating from the foregoing discussion of the requirements of 37 C.F.R. §1.104 and the procedure specified to be followed by the Examiner under §804 of the *Manual* for imposing an

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obviousness-type double patenting rejection, even a cursory reading of Applicant's independent apparatus claims 1, 13 and 16 illustrate an apparatus that is structurally, functionally and operationally different from the combination set forth in the independent claims 1 and 6 of Kim '026. Where as Applicant defines a novel combination of a front casing, rear casing and an engaging snap pin, Kim '026 defines a different front case section, rear case section, first guide and second guide means, in conjunction with a snapping device pull for engagingly locking [a] printed circuit board. Absent from the Examiner's rejection and explanation is any comparison of any of these limitations, or even a comparison between the pari of snap members, pair of supporting members and bottom shield of claim 1 of Kim '026 and the structurally different mutually engaging front and rear casings of Applicant's claim 1. Instead of making the necessary comparison of claims, the Examiner improperly invites a comparison between different pairs of the Figures. This approach to obviousness-type double patenting issues is not helpful to Applicant.

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Accordingly, the Commissioner is respectfully requested to:

A. Direct the Examiner to make a determination of the scope and content of each claim of Kim '026 in the prior art relative to each claim rejected in Applicant's application, as required under §804 of the *Manual*;

B. Direct the Examiner to make a determination of the differences between the scope and content of each claim of Kim '026 and prior art as determined in the foregoing prayer and each of the Applicant's rejected claims in the above-captioned application, as required by §804 of the *Manual*.

C. Direct the Examiner to make a determination of the level of the ordinary skill in prior art as is required by §804 of the *Manual*;

D. Direct the Examiner to make an evaluation of any objective indicia of non-obviousness as is required by §804 of the *Manual*.

E. Direct the Examiner to identify the differences between inventions defined by the applied claims of Kim '026 and each claim rejected, as is suggested by §804 of the *Manual*.

F. Direct the Examiner to state the reasons why a person of ordinary skill in the art would conclude that the invention defined in each rejected claim is an obvious variation of the invention defined in each claim of Kim '026 applied to support the rejection;

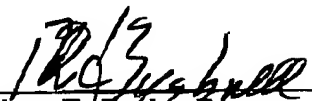
G. Find that the obviousness-type double patenting rejection set forth in Paper No.8 is incomplete and fails to comply with a mandate of 37 C.F.R. § 1.104(b) and (c);

H. Withdraw the designation of "final" from Paper No. 8; and

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I. Grant Applicant such other and further relief as justice may required.

Respectfully submitted,


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April 26, 2002

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Art Unit: 3636
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APR 26 2002

Re: U.S. Patent Application **GROUP 3600**
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Total Pages Including this Page: 8

Dear Examiner Fisher:

Accompanying this facsimile transmission is a REQUEST FOR CLARIFICATION AND
PETITION UNDER 37 C. F.R. §1.181 for the above-referenced application.

Kindly acknowledge receipt of all pages.

With best regards.

Respectfully submitted,

Robert E. Bushnell

Adjustment date: 09/09/2002 EKKURAY1
05/01/2002 LYONM 00000002 024943 09503240
01 FC:110 18.00 CR

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Enclosures

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